

REMARKS

Claims 1 to 18 were previously canceled and claims 19 to 36 are now pending in the above-referenced application.

Applicants respectfully request reconsideration of the present application in view of this response.

In response to the Office's comments that the information disclosure statement filed June 20, 2006 "fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent documents," Applicants respectfully note that the copies of the references need not be included since they are provided by the International Searching. The Search Report includes a list of documents that were considered by the Examiner in the underlying PCT application. Nevertheless, to facilitate matters, copies of the foreign references (cited in the previously filed IDS and form 1449) accompany this response. It is respectfully requested that they be considered and made of record.

Claims 1 to 8, 10 to 14, and 18 were rejected under 35 U.S.C. § 102(b) as anticipated by DE 4236009, EP 0866219, EP 0857866, 3P 0136544, JP 61034327, JP 11117790, and FR 2481366.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

Moreover, regarding the level of detail of explanation of the anticipation rejection in the Office Action, MPEP § 706 specifically requires that the "goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest

opportunity.” Furthermore, MPEP § 707.05 requires that “[d]uring the examination of an application or reexamination of a patent, the examiner should cite appropriate prior art which is nearest to the subject matter defined in the claims,” and that “when such prior art is cited, its pertinence should be explained.” Finally, MPEP § 707 requires that “when considered necessary for adequate information, the particular figure(s) of the drawing(s), and/or page(s) or paragraph(s) of the reference(s), and/or any relevant comments briefly stated should be included.”

It is respectfully submitted the present Office Action does not explain how the present claims are anticipated by the DE 4236009, EP 0866219, EP 0857866, 3P 0136544, JP 61034327, JP 11117790, and FR 2481366 references under 35 U.S.C. § 102(b), since the Office Action merely lists the claim numbers and then conclusorily asserts that each cited reference in its entirety corresponds to the claim language. *These are nothing more than omnibus rejections which the office does not permit.* Applicants respectfully submit that the Office has, by only providing mere conclusory statements, failed to satisfy its burden to articulate a prima facie case. Without adequate notice of the basis of this rejection, the burden to rebut this rejection with evidence and/or argument has not yet shifted to Applicants. Applicants therefore respectfully request a proper explanation, as required by the Office Rules and the M.P.E.P.

It is respectfully submit that claim 19 differs from the subject matter of the asserted cited references, since claim 19 includes the feature of *selecting at least one of an ignition angle and a gear ratio as the at least one actuating variable*. In contrast to the use of the air supply or the fuel supply as an actuating variable, this results in a significantly faster implementation of a driver command when leaving the overrun condition. By using the ignition angle and/or the gear ratio as an actuating variable, an opening of the throttle valve may be avoided, in particular in the non-firing overrun condition. In addition to having the described negative effect during the transition from the overrun condition to the acceleration condition, such an opening of the throttle valve also results in an undesired cooling off of a possibly present catalytic converter. Such a cooling off of the catalytic converter is prevented if the ignition angle and/or a gear ratio are/is selected as the actuating variable.

None of the asserted cited references identically disclose nor suggest all the features of claim 19.

Accordingly, claim 19 is allowable (as are its dependent claims 20 to 35), since none of the references identically disclose (or suggest) this feature. The Office has not presented a

prima facie case of anticipation since it only made impermissible conclusory and general omnibus rejections without any reasoning whatsoever. The M.P.E.P. provisions explicitly prohibit such rejections.

Claim 36 contains features like those of claim 19 and is therefore allowable for at least the same reasons as claim 19.

It is therefore respectfully requested that the anticipation rejections of claims 19 to 36 be withdrawn.

CONCLUSION

It is therefore respectfully submitted that all of pending and considered claims 19 to 36 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

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Respectfully submitted,

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